

ESTTA Tracking number: **ESTTA454714**

Filing date: **02/03/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Rare Breed M.C. Inc.
Granted to Date of previous extension	02/04/2012
Address	301 N. Dahlia Drive Anaheim, CA 92801 UNITED STATES
Attorney information	Mary Joe Weston Simplicity Law, Inc. 11852 Shaffer Drive, Bldg D Suite 200 Littleton, CO 80127 UNITED STATES maryjoe@simplicitylaw.com Phone:303-948-1640

Applicant Information

Application No	85233716	Publication date	12/06/2011
Opposition Filing Date	02/03/2012	Opposition Period Ends	02/04/2012
Applicant	RARE BREED MOTORCYCLE CLUB INC. www.rarebreedmc.com 15320 S Broadway Gardena, CA 90247 UNITED STATES		

Goods/Services Affected by Opposition

Class 041. First Use: 1989/08/01 First Use In Commerce: 1989/08/01
All goods and services in the class are opposed, namely: Arranging, organizing, conducting, and hosting social entertainment events

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

Marks Cited by Opposer as Basis for Opposition

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	Rare Breed		
Goods/Services	Goods and Services:Motorcycle and Social club; promoting cross country and inter-city motorcycle rides; arranging, organizing and		

	conducting social and charitable events and activities.
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U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	"Rare Breed M.C. Nomad" with an eagle head.		
Goods/Services	promoting cross country motorcycle rides		


U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		

Design Mark			
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Goods/Services	Motorcycle and Social club; promoting cross country and inter-city motorcycle rides; arranging, organizing and conducting social and charitable events and activities.		
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U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	"Rare Breed M.C. So. Calif." with a drawing of an eagle head.		
Goods/Services	promoting cross country and inter-city motorcycle rides		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		

Design Mark	
Goods/Services	Motorcycle and Social club; promoting cross country and inter-city motorcycle rides; arranging, organizing and conducting social and charitable events and activities.

Attachments	MC_STATEMENT_OF_OPPOSITION[1].pdf (6 pages)(50353 bytes) High Qual RB MC 950.jpg Untitled 7 950.jpg
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Mary Joe Weston/
Name	Mary Joe Weston
Date	02/03/2012

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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STATEMENT OF OPPOSITION

Opposer, Rare Breed M.C., Inc., of 301 N. Dahlia Drive, Anaheim, CA 92801 (“Rare Breed MC” and/or “Opposer”) believes that it will be damaged by the registration of Serial No. 85233716 and hereby Objects to said registration. As grounds of this Objection, it is alleged on information and belief that:

HISTORY OF THE RARE BREED MOTORCYCLE CLUB AND ITS MARKS

1. The Rare Breed Motorcycle Club was founded as an unincorporated association of motorcycle enthusiasts in January 1989.

2. The members of the Rare Breed Motorcycle Club created, and in the some cases abandoned various affiliated corporate entities and unincorporated chapters of the club over its 23 year history, including Rare Breed, RareBreed Motorcycle Club Inc., Rare Breed M.C., Inc., Rare Breed Motorcycle Club Atlanta GA Chapter, Inc., Rare Breed Mother Chapter, and Rare Breed South Bay Chapter.

3. Opposer, Rare Breed M.C., Inc. was incorporated and registered with the California Secretary of State on July 12, 2005, pursuant to a vote of the members of the Rare Breed Motorcycle Club, and as such, is a legitimate successor in interest to the original unincorporated Rare Breed Motorcycle Club.

4. Opposer, on it’s own behalf and as a legitimate successor in interest to the unincorporated Rare Breed Motorcycle Club, has common law rights in the numerous Rare Breed word and combined word and eagle design marks, and the trade dress created, owned and used by the Rare Breed Motorcycle Club and its members (the “Rare Breed Marks”).

APPLICANT IS NOT A VALID CORPORATION

5. Applicant represents a small splinter group of the Rare Breed Motorcycle Club members, is a usurper of the Rare Breed Marks, including Applicant’s Mark, and should not be granted exclusive rights to the Rare Breed Marks to the exclusion of Opposer and other legitimate affiliates and members of the Rare Breed Motorcycle Club.

6. Further, the Applicant “Rare Breed Motorcycle Club, Inc.” as identified in the application, does not exist in the records of the Office of the California Secretary of State. There is no such legal entity.

7. A California corporation named “RareBreed Motorcycle Club Inc.” was incorporated on October 11, 2005. This corporation is currently delinquent and the status of the entity is “Suspended” in the records of the California Secretary of State.

8. A California corporation named simply “Rare Breed” was incorporated on November 13, 2000, and was subsequently suspended by the California Secretary of State and abandoned by the membership of the Rare Breed Motorcycle Club.

9. The “Rare Breed” entity was inactive and on “Suspended” status at the time of Applicant’s application and remained suspended until November or December of 2011.

10. The “Rare Breed” entity was not asserted as the owner in Applicant’s application and Applicant should not be granted leave to amend the ownership information of it’s application at this time.

11. Applicant, as identified in the application, is not a State of California corporation, and either does not exist as a legal entity or is an entity that was abandoned by the Rare Breed Motorcycle Club and is not in good standing with the State of California.

12. Registration of any mark by the Applicant, as identified in the application, should be denied.

LIKELIHOOD OF CONFUSION AND PRIORITY

13. Opposer is a legitimate user of the Rare Breed Marks as an affiliate and successor in interest to the unincorporated Rare Breed Motorcycle Club and in its own right is the owner of the following State of California trademark registrations (the “CA Marks”):

CA Registration No. 062448, August 16, 2005, Int. Class 041: Promote cross country motorcycle rides; Described as “ON THE BACK OF A JACKET OR VEST “RARE BREED” AT THE TOP WITH AN AMERICAN BALD EAGLE IN THE CENTER WITH “M.C.”

CA Registration No. 062449, August 16, 2005, Int. Class 041: Promote cross country motorcycle rides; Described as “ON THE BACK OF A JACKET OR VEST “RARE BREED” AT THE TOP WITH AN AMERICAN BALD EAGLE IN THE CENTER WITH “M.C.” “NOMAD” AT THE BOTTOM.”

CA Registration No. 062519, September 1, 2006, Int. Class 041: Promote inter-city and cross country motorcycle rides described as “ON THE BACK OF A JACKET OR VEST “RARE BREED” AT THE TOP WITH AN AMERICAN BALD EAGLE IN THE CENTER WITH “SO. CALF.” “M.C.” AT THE BOTTOM.”

14. Opposer has priority over Applicant because its legitimate use of the Rare Breed Marks, as an affiliate and successor in interest to the unincorporated Rare Breed Motorcycle Club, has been valid and continuous since January 1989, and has not been abandoned.

15. Opposer has priority over Applicant because its registration and use of the CA Marks has been valid and continuous since July 12, 2005, and has not been abandoned.

16. Applicant filed trademark application Serial No. 85233716 to Register RARE BREED in connection with International Class 041: Arranging, organizing, conducting, and hosting social entertainment events, on February 3, 2011 (“Applicant’s Mark”).

17. Applicant’s Mark is confusingly similar to the CA Marks and the Rare Breed Marks because it is identical to the prevalent word portion of such marks.

18. Applicant’s services are similar and directly related, if not identical, to Opposer’s services and activities.

19. Ordinary consumers of the services and public participants in the activities are likely to be confused as to the source and sponsorship of the services and activities.

20. Opposer’s use of the CA Marks and the Rare Breed Marks, as an affiliate and successor in interest to the unincorporated Rare Breed Motorcycle Club, began prior to Applicant’s application to Register Applicant’s Mark and prior to Applicant’s use of Applicant’s Mark.

21. Applicant’s purpose in registering Applicant’s Mark is Applicant’s misguided effort to prevent and curtail Opposer’s valid and continuous use of the CA Marks and the other Rare Breed Marks.

22. Opposer has standing because it would be damaged by the registration of Applicant’s Mark by Applicant. Opposer’s Rare Breed Marks and CA Marks represent extensive good will and public recognition. As a result of substantial time and effort in advertising and promotion, Opposer has developed exceedingly valuable goodwill with respect to the Rare Breed Marks and the CA Marks.

APPLICANT’S BAD FAITH AND FRAUD

23. Applicant filed the instant application in bad faith, with a fraudulent purpose and the intent to secure Federal registration by deception.

24. Applicant had prior knowledge of the valid, continuous use of the various Rare Breed Marks by the members of the Rare Breed Motorcycle Club and other entities and chapters of the Rare Breed Motorcycle Club, including Opposer, and Rare Breed Motorcycle Club Atlanta GA Chapter, Inc. of Georgia, which use has not been

abandoned.

25. Applicant had prior knowledge of the Opposer's ownership of the CA Marks and of the valid and continuous use of the CA Marks that has not been abandoned.

26. The specimens submitted by Applicant with the original application and on October 13, 2011, misrepresent Applicant as the sole source of the events and activities. The events and activities were in fact arranged and hosted by various entities including the unincorporated Rare Breed Motorcycle Club, its members, and other Rare Breed corporate entities and chapters.

27. Further, the www.rarebreedmc.com website claimed by Applicant, is not owned by Applicant. It is owned by the Rare Breed Motorcycle Club Atlanta GA Chapter, Inc. and operated in association with Opposer

28. Applicant's Mark infringes on the legal rights of Opposer, the members of the Rare Breed Motorcycle Club, Rare Breed Motorcycle Club Atlanta GA Chapter, Inc.

29. Applicant was well aware of the legal rights of the owners and other legitimate users of the Rare Breed Marks and as a formerly affiliated entity or as representing affiliated individuals and members of the unincorporated Rare Breed Motorcycle Club, Applicant had no basis to believe otherwise.

30. Applicant, Opposer, Rare Breed Motorcycle Club members, entities and chapters are all associated with the same Rare Breed Motorcycle Club.

31. Applicant's purpose in registering Applicant's Mark is to prevent the valid and continuous use of the Rare Breed Marks and the CA Marks by Opposer, members of the Rare Breed Motorcycle Club, Rare Breed Motorcycle Club Atlanta GA Chapter, Inc., and by other Chapters of the Rare Breed Motorcycle Club.

32. By failing to disclose the above facts and circumstances to the USPTO, Applicant intended to obtain a Federal trademark registration to which it is not entitled.

33. In view of the similarity of the marks and nearly identical nature of the services, Applicant's Mark is likely to cause confusion or mistake or deceive, thereby causing loss, damage and injury to Opposer, the Rare Breed Motorcycle Club, the members of the Rare Breed Motorcycle Club and the public, and to disparage and deny Opposer's legitimate use of the Rare Breed Marks and the CA Marks, thereby causing loss, damage and injury to Opposer, the Rare Breed Motorcycle Club, the members of the Rare Breed Motorcycle Club and the public.

WHEREFOR, Opposer prays that this Notice of Opposition be sustained and the registration of Applicant's Serial No. 85233716 be refused registration by the U.S. Patent and Trademark Office.

/Mary Joe Weston/

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PROOF OF SERVICE BY MAIL

I certify that on this 3rd day of February 2012, a copy of the foregoing Statement of Opposition and Notice of Opposition, was served on Applicant Rare Breed Motorcycle Club Inc., postage prepaid at the following addresses:

Law Offices of George L. Steele
127 N. Madison Ave, Suite 24
Pasadena, CA 91101

/Laura Antonio/
Laura Antonio